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| 10/561,010      | 04/18/2007  | Myriam Bouet-Griffon | 2901683-000026      | 6015             |

59554 7590 04/13/2010  
Baker Donelson Bearman Caldwell & Berkowitz PC  
Att: Docketing Sixth Floor  
555 11th Street N.W.  
Washington, DC 20004

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| EXAMINER |
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LEE, REBECCA Y

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| ART UNIT | PAPER NUMBER |
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1793

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|-------------------|---------------|
| NOTIFICATION DATE | DELIVERY MODE |
|-------------------|---------------|

04/13/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroomdc@bakerdonelson.com  
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|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/561,010 | <b>Applicant(s)</b><br>BOUET-GRIFFON ET AL. |  |
|                              | <b>Examiner</b><br>REBECCA LEE       | <b>Art Unit</b><br>1793                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/19/10 has been entered.

### ***Status of Claims***

Claims 1, 3-5 and 7-20 are pending where no claim has been amended.

### ***Status of Previous Rejections***

The rejections of claims 1, 3-5 and 7-20 under 35 U.S.C. 103(a) have been withdrawn in view of declaration filed 02/19/10.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (JP 2002-371333).

Sato et al. teach an aluminum alloy sheet with a thickness of 1 mm, having a composition relative to that of the instant invention, in weight percent, as shown in the table below (abstract and section 0034).

| Element        | Instant claims            | Sato et al.                                       | overlap                   |
|----------------|---------------------------|---|---------------------------|
| Si             | 0.7-1                     | 0.4-1.8   | 0.7-1                     |
| Fe             | 0-0.5                     | 0.02-0.5  | 0.02-0.5                  |
| Cu             | 0.8-1.1                   | 0.1-1.5   | 0.8-1.1                   |
| Mn             | 0.45-0.6                  | 0.03-1.5  | 0.45-0.6                  |
| Mg             | 0.6-0.9                   | 0.2-1.6   | 0.6-0.9                   |
| Zn             | 0.15-0.3                  | 0.05-6  | 0.15-0.3                  |
| Cr             | 0-0.25                    | 0.02-0.5  | 0.02-0.25                 |
| Zr+Ti          | 0-0.20                    | Zr: 0.02-0.5<br>Ti: 0.003-0.2<br>Zr+Ti: 0.023-0.7 | 0.023-0.20                |
| Other elements | <0.05 each<br><0.15 total | 0+  | <0.05 each<br><0.15 total |
| Al             | balance                   | balance   | balance                   |

The amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al disclosed by Sato et al. overlap the claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al, which is prima facie evidence of obviousness MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to have selected claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al from the amounts disclosed by Sato et al. since Sato et al. discloses the same utility throughout the disclosed ranges.

Sato et al. further teach the aluminum alloy sheet would have a yield strength greater than 220 MPa before and after the paint baking (table 3), which overlaps the claimed ranges.

Even though Sato et al. do not expressly teach the yield strength after solution treatment, quenching and aging, such properties would have been expected since Sato et al. disclose a substantially identical alloy sheet as claimed MPEP 2112.01.

In addition, the claimed limitations of solution treatment, quenching and aging steps are considered as process limitations in product by process claims. It is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. In this case, Sato et al. teach an aluminum alloy that is substantially the same as claimed. Therefore, the burden falls upon the applicant to show that the process steps of Sato et al. result in a materially different Al alloy product.

Furthermore, Sato et al. teach the aluminum alloy sheet, which is subjected to paint baking as claimed, would be used as automobile material (section 0001), and attached to a steel component, such as a body skin part as claimed.

Claims 1, 3-5, 7-10, 12-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (JP 2002-371333) in view of Izumi et al. (US 6678936).

Sato et al. teach an aluminum alloy sheet with a thickness of 1 mm, having a composition relative to that of the instant invention, in weight percent, as shown in the table below (abstract and section 0034).

| Element        | Instant claims            | Sato et al.                                       | overlap                   |
|----------------|---------------------------|---|---------------------------|
| Si             | 0.7-1                     | 0.4-1.8   | 0.7-1                     |
| Fe             | 0-0.5                     | 0.02-0.5  | 0.02-0.5                  |
| Cu             | 0.8-1.1                   | 0.1-1.5   | 0.8-1.1                   |
| Mn             | 0.45-0.6                  | 0.03-1.5  | 0.45-0.6                  |
| Mg             | 0.6-0.9                   | 0.2-1.6   | 0.6-0.9                   |
| Zn             | 0.15-0.3                  | 0.05-6  | 0.15-0.3                  |
| Cr             | 0-0.25                    | 0.02-0.5  | 0.02-0.25                 |
| Zr+Ti          | 0-0.20                    | Zr: 0.02-0.5<br>Ti: 0.003-0.2<br>Zr+Ti: 0.023-0.7 | 0.023-0.20                |
| Other elements | <0.05 each<br><0.15 total | 0+  | <0.05 each<br><0.15 total |
| Al             | balance                   | balance   | balance                   |

The amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al disclosed by Sato et al. overlap the claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al, which is prima facie evidence of obviousness MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art to have selected claimed amounts of Si, Fe, Cu, Mn, Mg, Zn, Cr, Zr, Ti and Al from the amounts disclosed by Sato et al. since Sato et al. discloses the same utility throughout the disclosed ranges.

Sato et al. further teach the aluminum alloy sheet would have a yield strength greater than 220 MPa before and after the paint baking (table 3), which overlaps the claimed ranges.

Even though Sato et al. do not expressly teach the yield strength after solution treatment, quenching and aging, such properties would have been expected since Sato et al. disclose a substantially identical alloy sheet as claimed MPEP 2112.01.

In addition, the claimed limitations of solution treatment, quenching and aging steps are considered as process limitations in product by process claims. it is well

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settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See *In re Thorpe*, (227 USPQ 964), *In re Brown*, (173 USPQ 685), *In re Fessman*, (180 USPQ 524) and MPEP 2113. In this case, Sato et al. teach an aluminum alloy that is substantially the same as claimed. Therefore, the burden falls upon the applicant to show that the process steps of Sato et al. result in a materially different Al alloy product.

Furthermore, Sato et al. teach the aluminum alloy sheet, which is subjected to paint baking as claimed, would be used as automobile material (section 0001), and attached to a steel component, such as a body skin part, but do not expressly teach that the aluminum alloy would be a body roof.

Izumi et al. teach aluminum alloys would be used as a body roof (Column 1, lines 13-23).

It would have been obvious to one of ordinary skill in the art to use the aluminum alloy of Sato et al. as a body roof, as claimed, with expected success.

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 02/19/10 is sufficient to overcome the rejection of claims 1, 3-5 and 7-20 based upon Evancho et al. (US4082578).

***Response to Arguments***

Applicant's arguments with respect to claims 1, 3-5 and 7-29 have been considered but are moot in view of the new ground(s) of rejection. Applicant's argument directed to the Cu content has been addressed above.

***Conclusion***

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REBECCA LEE whose telephone number is (571)270-5856. The examiner can normally be reached on Monday-Friday 8:00 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JERRY LORENZO can be reached on (571)272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L./  
Examiner, Art Unit 1793

/J.A. LORENZO/  
Supervisory Patent Examiner, Art  
Unit 1793